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Proceeding	91204070
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8	BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD		
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10	Brody Chemical Company, Inc.	OPPOSITION NO. 91/204,070	
11	Opposer,	Mark: Slippery Wizard	
12	V.	Serial No. 85/099,334	
13	Goldthorpe, Tammy L. fka Tammy Price,		
14	Applicant.		
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19	OPPOSER'S	OPENING BRIEF	
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THE RECORD The record before the Board includes the matters contained in Applicant's file wrapper as well as the following trial depositions and the twenty-one (2) trial exhibits introduced therein: 1. Jon Liddiard testimony dated January 30, 2013 2. Buzz Butler testimony dated January 30, 2013 Buzz Butler testimony dated May 20, 2013 3. 4. Matt Forsgren testimony dated May 20, 2013 5. Dennis Brunetti testimony dated May 20, 2013 Tammy Goldthorpe testimony dated May 20, 2013 6. 7. Nancy Ayers testimony dated May 20, 2013

OPPOSER'S OPENING BRIEF

I. Introduction.

Opposer is seeking to block registration by its former employee Tammy Goldthorpe of the SLIPPERY WIZARD trademark that has been used exclusively by Brody Chemical to label and identify one if its asphalt release products since October of 2004.

Brody Chemical first began using the SLIPPERY WIZARD mark in October of 2004. Tammy Goldthorpe worked as a sales representative for Brody Chemical from October 2004 until January of 2011. On August 3, 2010, while still employed by Brody Chemical and still selling Brody Chemical's SLIPPERY WIZARD asphalt release product, Goldthorpe filed a trademark application with the United Statement Patent and Trademark office for the mark SLIPPERY WIZARD for an asphalt release agent, claiming a date of first use of October 1, 2004, the first day of her employment by Brody Chemical.

Brody Chemical discovered the trademark application filed by Applicant during the term of her employment only after Goldthopre resigned her employment in January of 2011. Thereafter Brody Chemical filed its own trademark application for SLIPPERY WIZARD (Serial No. 76,707,090) and, after Goldthorpe's mark was published in the Federal Register, filed a timely Notice of Opposition.

As discussed below, Goldthorpe has never used SLIPPERY WIZARD to identify herself as the source or origin of any goods sold under that mark. Rather, since October of 2004 the SLIPPERY WIZARD mark has always and only identified Brody Chemical's asphalt release products. Indeed, the very specimen that Goldthorpe submitted to the Trademark Office with her application in fact evidences Brody Chemical's use of the SLIPPERY WIZARD mark and not her own.

As discussed below, the trial testimony of the parties is conflicting as to who first thought of the SLIPPERY WIZARD name for and how that mark was adopted by Brody Chemical for one of its asphalt release products. Brody' Chemical's president Jon Liddiard testified that the name was selected after a brainstorming session including a number of Brody Chemical managers. Goldthorpe

testified that she thought of it before she was hired by Brody Chemical in October of 2004 and that Brody Chemical, with her permission, simply adopted and used the name that she had thought of.

Ultimately, however, the resolution of this fact dispute is irrelevant. Trademarks do not grant inchoate rights like patents or copyrights. A party cannot obtain rights for thinking of an "idea" for a trademark. Rather, trademark rights are limited property rights gained by actual use of the mark.

In this case, the SLIPPERY WIZARD mark has only ever identified Brody Chemical's asphalt release product. It has never been used to label or identify an asphalt release product sold by Applicant. Goldthorpe never sold a product under the SLIPPERY WIZARD mark prior to joining Brody Chemical as an employee and has not sold or labeled a product under the SLIPPERY WIZARD mark after resigning her employment from Brody Chemical in January of 2011.

In sum Opposer has established through the evidence admitted at trial priority of use of the SLIPPERY WIZARD mark. As a result, the Board should reject Applicant's trademark application.

II. The Law: Trademarks Are Only Symbols Of Goodwill Of The Product(s) They Symbolize: "There Is No Such Thing As Property In A Trademark Except As A Right Appurtenant To An Established Business Or Trade In Connection With Which The Mark Is Employed."

It is axiomatic that trademark rights arise from use. McCarthy teaches that trademarks are symbols of good will:

"A trademark is a very peculiar kind of property. For it has no existence apart from the good will of the product or service it symbolizes. Good will of a business and its symbol, a trademark, are inseparable."

* * *

"The Supreme Court has noted that trademarks, unlike patents and copyrights, have no existence independent of the article, service or business in connection with which the mark is used. It is a "fundamental error" to suppose "that a trademark right is a right in gross or at large, like a statutory copyright or a patent for an invention, to either of which, in trust, it has little or no analogy"

2 McCarthy on Trademarks and Unfair Competition § 2:15 at p. 2-40 (Release # 65, March 2013) (quoting United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 63 L. Ed. 141, 39 S. Ct. 48 (1918). In the words of the Supreme Court: "There is no such thing as property in a trademark except as a

right appurtenant to an established business or trade in connection with which the mark is employed." United Drug, 248 U.S. 90.

Judge Learned Hand described the limited rights conveyed by a trademark as follows:

"[A] trademark is not property in the ordinary sense, but only a word or symbol indicating the origin of a commercial product. The owner of the mark acquires the right to prevent the goods to which the mark is applied from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks. There are no rights in a trademark beyond these."

Industrial Rayon Corp. v. Dutchess Underwear Corp., 92 F.2d 33 (2nd Cir. 1937) cert. denied, 303 U.S. 640, 82 L. Ed. 1110, 58 S. Ct. 610 (1938) (emphasis added).

In this case, it is only Brody Chemical, not Goldthorpe, who has actually applied the mark to its goods.

III. Because The Undisputed Facts At Trial Establish That The Contested SLIPPERY WIZARD Mark Has Only And Ever Identified Brody Chemical's Asphalt Release Product, Applicant's Trademark Application Should Be Rejected By The Board.

Prior to joining Brody Chemical in October of 2004, Goldthopre did not own her own business but rather worked as an employee for another chemical company, RCAI. Goldthorpe claims ownership of the SLIPPERY WIZARD mark despite the fact that she was employed by Brody Chemical at the time the mark was first used in commerce to identify an asphalt release product. As discussed below, Goldthorpe is under a fundamental misapprehension of how trademark rights accrue.

With regard to the respective rights of employees and employers in trademarks, McCarthy summarizes the law as follows:

"Ownership as between employer and employee will depend upon who first use the term as a mark and who the mark identifies. If an employee designs a mark in the course of employment and the employer uses it, it would seem clear that the employer is the "owner" of the mark. But if a person was in business and sold a product under a mark, and then entered into employment under an agreement to assign to the employer all marks developed as an employee, the employee, not the employer, is the owner of the pre-employment mark."

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2 McCarthy on Trademarks and Unfair Competition § 16:36 at 16-73 (4th Ed. 2012).

In this case, prior to joining Brody Chemical as an employee in October of 2004, Goldthopre was not "in business" for herself and did not sell any product under the SLIPPERY WIZARD mark. Rather, the SLIPPERY WIZARD mark was first used to identify Brody Chemical's asphalt release product and the undisputed testimony at trial establishes that the SLIPPERY WIZARD mark has always and only ever identified Brody Chemical's asphalt release product. This evidence includes the following admissions made by Goldthorpe in her trial testimony:

- Prior to Joining Brody Chemical in October of 2004 Goldthorpe never sold an asphalt release product under the name SLIPPERY WIZARD (Tammy Goldthorpe Trial Deposition (hereafter, "Golthorpe Tr."), at p. 29:12-16; attached as Exhibit "A" hereto).
- For her sales of Brody Chemical's SLIPPERY WIZARD asphalt release product made during the term of her affiliation with Brody Chemical (October 2004 through January of 2011), Goldthorpe was compensated as though she was an employee of Brody Chemical. (Goldthorpe Tr. (Exh. A), at p. 31:6-22).
- During the entire time that Goldthorpe was affiliated with Brody (October 2004 to January 2011) she never paid the employer contribution for FICA taxes as though she were self-employed (Goldthorpe Tr. (Exh. A), at p. 51:21-52:8).
- During the time she was associated with Brody Chemical Goldthorpe never received a 1099 tax form from Brody Chemical; rather she always only received a Form W-2 which discloses employee compensation. (Goldthorpe Tr. (Exh. A), at p. 32:5-10).
- The labeling of the SLIPPERY WIZARD product sold by Brody Chemical has never identified Goldthorpe as the source or sponsor of the product; it's

never been labeled "Tammy Goldthorpe's Slipper Wizard." (Goldthorpe Tr. (Exh. A), at p. 37:10-14).

- During the time period from October of 2004 until she left Brody in January of 2001, Goldthorpe never used any business cards other than business cards that associated you as being associated with Brody Chemical. (Goldthorpe Tr. (Exh. A), at 33:8-23).
- Goldthorpe has not sold any asphalt release product under any name since leaving Brody Chemical's employ in January of 2011. (Goldthorpe Tr. (Exh. A), at pp. 35:19-36:24).

Finally, Goldthorpe admitted that the very specimen she submitted to the Trademark Office to evidence her alleged use of the SLIPPERY WIZARD mark (Trial Exhibit 4) in fact demonstrated Brody Chemical's use of the SLIPPERY WIZARD mark:

Q: And the specimen that you or your attorney submitted with your trademark application to the United States Patent and Trademark Office, that demonstrated or that showed Brody Chemical['s] use of the Slippery Wizard mark, correct?

A: Yes.

(Goldthorpe Tr. (Exh. A), at p. 37:15-20).

Brody's former National Sales Manager and Tammy's supervisor, Matt Forsgren, is familiar with the asphalt releases that have been on the market and he is not aware of anybody except Brody Chemical selling an asphalt release product labeled "SLIPPERY WIZARD". (Forsgren Trial Testimony (hereafter, "Forsgren Tr.") at p. 36:2-22; attached as Exhibit "B" hereto). Forsgren further testify that, at least through the date that he stopped working Brody Chemical in July, 2006, the SLIPPERY WIZARD mark was only used to identify Brody Chemical's asphalt release product (*e.g.* Trial Exhibit 8) and that the mark was never used to identify Goldthorpe. (Forger Tr. (Exh. B), at

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41:14-42:1). He further testified consistently with Brody Chemical's founder and owner Jon Liddiard that Goldthorpe was hired by Brody Chemical as a sales representative employee in October of 2004:

Q: And you did hire Tammy Price as a sales representative, correct?

A: Correct?

Q: And she became employee by Brody Chemical as a sales representative in approximately October of 2004, correct?

A: Yes

Q: There was no doubt in your mind as to the fact that she was an employee of Brody Chemical, correct?

A: Yes. She worked for Brody.

(Forsgren Tr. (Exh. B), at p. 38:21-39:13.)

Goldthorpe offers only one rebuttal to all of this evidence: Goldthorpe argues that a written agreement regarding payment of override commissions to Goldthorpe on other Brody Chemical employees' sales of Brody Chemical's SLIPPERY WIZARD asphalt release product (Trial Exhibit 4) entered into by the parties' in 2006 -- nearly two years after Brody Chemical first began using the SLIPPERY WIZARD mark in commerce -- constitutes a trademark "license" that somehow either granted or evidenced superior rights to her in a mark she, Goldthorpe, never applied to a product and never herself used in commerce. As discussed below, Goldthorpe's argument is nonsense.

Brody Chemical's founder and owner Jon Liddiard testified that Exhibit 4 is consistent with other agreements Brody Chemical entered into with other managers for the payment of override commissions. Exhibit 4 does not use the words "trademark" or "license" anywhere in the document. Indeed, Goldthorpe admitted that has never seen any document that referred to the override commission on SLIPPERY WIZARD sales at Brody Chemical as a "royalty." (Goldthorpe Tr. (Exh. A), at p. 40:12-17.) Moreover, there are no provisions in Exhibit 4 giving Goldthorpe the right to monitor and/or control the quality of Brody Chemical's SLIPPERY WIZARD product. The agreement is further totally silent as to whether it is an exclusive or non-exclusive "license," the term of the supposed "license," whether or how, specifically, the alleged licensor can exercise any quality control over the goods sold pursuant to the alleged "license," whether Brody Chemical has any reporting obligations, whether the alleged licensor has any audit rights, whether and how and under

what circumstances the alleged "license" could be terminated, and whether the supposed "license" is perpetual or for a term.

Finally and most importantly, Exhibit 4 does not change the fact that Goldthopre has never used the SLIPPERY WIZARD mark to identify or mark any products that she has ever sold or offered to sell in commerce. Rather, SLIPPERY WIZARD mark has always and only identified Brody Chemical's asphalt release products. Even the specimen that Goldthorpe submitted with her application in evidences *Brody Chemical's use* of the SLIPPERY WIZARD not her own!

IV. Conclusion.

The SLIPPERY WIZARD mark belongs to Brody Chemical, not Goldthopre. The parties' trial testimony and exhibits conclusively establish that it is Brody Chemical who has continuously used the SLIPPERY WIZARD mark to identify its goods in commerce since October of 2004 and that Applicant has never labeled or advertised any goods under the mark SLIPPERY WIZARD that identified her as the source or origin of the goods sold. As such, the Board should not permit Goldthorpe's trademark application to mature into a trademark for registration.

DATED this 16^{th} day of September, 2013.

DICKINSON WRIGHT/MARISCAL WEEKS

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CERTIFICATE OF DEPOSIT

I hereby certify that this correspondence is being deposited with the Trademark Trial and Appeal Board via ESTTA on the date indicated below:

Date of Deposit 9/16/13

/David G. Bray/

CERTIFICATE OF SERVICE The undersigned hereby certifies that a true and correct copy of the foregoing OPPOSER'S OPENING BRIEF was served on Applicant by depositing said true and correct copy with the United States Postal Service, First Class Mail, postage prepaid, this 16th day of September, 2013, in an envelope addressed to Applicant's attorney of record as follows: Nathan S. Winesett AVERY, WHIGHAM & WINESETT, P.A. P.O. Box 3277 Duluth, MN 88508 A courtesy copy of the foregoing was also e-mailed to Mr. Winesett at nwinesett@awwlegal.com on this date. /David G. Bray/ PHOENIX 54392-2 90895v1